Application number: 09/534233 **Art Unit:** 3628
Applicant: Khai Hee Kwan **Examiner:** Clement, B Graham.
Title: System and method for conducting an electronic financial asset deposit auction over computer network

Huberman shows the identities while are known to the broker, they are concealed from the transaction party until reveal by broker. Breen has anonymity as an option and once anonymity is chosen, it is not reversible to reveal the identities. None of the prior arts specifically reveals deposit auction and in particular where the bidders placed deposit term bids effectively agreeing to accept deposits for a period of time.

The bids' manner and form include non monetary bids for exchanging interest/principal with shares as an alternative to interest cost of money. The system is also designed for applicant to deposit shares in lieu of money. The word 'deposit' is in reference to deposit with deposit-taking institution. The selected deposit-taking institutions which have submitted bids get to access the name and contacts of the anonymous applicant (handled) wherein the manner of access is within the control of the applicant. The significance of the these limitations "deposit", "deposit application" and "deposit taking institution" found in our claimed invention and missing from the prior arts must suggest that our problem for soliciting competitive bids for depositor is not found therein. Furthermore, it is clear that this is a programmed machine adapted for deposit auction, a subject matter not found in the prior arts nor suggesting such limitations as found in our claimed invention. It is noted that in Pennwalt Corp v Durand-Wayland, Inc (833 F 2.d 931, 4 USPQ 2 d 1737 (Fed Cir.1987)(en banc), cert denied, 485 US 961 (1988), held that a device or process that includes a substantially different function will not be considered an equivalent (See at 1743).

SUMMARY

Non Analogous Art/Field.

We respectfully submit that it has not been shown by the examiner that one skilled in the art of deposit (money and/or shares) taking seeking to solve a problem of promoting competitive rates return, would reasonably be expected or motivated to look at an auction for document service supplier (Huberman) and an auction for anonymously buying and selling regulated goods, such as agricultural chemicals (Breen). The combination of elements from non-analogous sources, in a manner that allegedly reconstructs our claimed invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness as per Oetiker (In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed Cir 1992)). There must be some reason, suggestion or motivation

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found in the prior arts whereby a person of ordinary skill in the field of the invention would make combination. The examiner provided no suggestion or reason how said person could reach the applicant's competitive deposit taking problem from both prior arts. (Note in Oetiker at least one of the prior arts was in the same field). The suggestion by the examiner " in order to facilitate transactions between buyers and sellers without identifying the parties involves in the transaction " is not found in Huberman, as Huberman's facilitation actually includes revealing the identities so to allow requester to decide. This is in contrast to soliciting bids in Huberman where a brokering function is used. Even if there is such a suggestion, this is redundant as the broker already shields the identities of the parties involves in the initial bidding and reveal them for selection purposes. There is no suggestion that by using a broker service it is necessary to use anonymity feature and more importantly there is a further requirement in Huberman's method to allows at least the winning identities of the seller to be known to requester. This would teach against the stated motivation.

There is also no evidence to show Huberman's brokering method fails to facilitate transactions between buyers and sellers such that it must necessarily use anonymity means in order to facilitate transactions. It also reveals no advantages by doing so. As stated in In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997), the nature of the problem cannot be used as motivation when the problem had not been previously identified anywhere in the prior art.

Hurberman clearly shows both parties are known to the broker (ie broker know both requesters and printers) whereas our claimed invention in Claim 15 provides for a first period where one of the party is identified and second period where the unidentified party reveal itself to selected identified parties without the use of a broker. This is the distinguishing feature as it provides 'control' to the applicant/requester which is not found in either prior arts even if they are able to combine.

Furthermore, our claimed invention reiterates the need for 'handles' and not merely bare anonymity as found in Breen (Breen uses the word 'ANONYMOUS' throughout in lieu of actual name of user). The underlying reason is because our claimed invention is used to solicit competitive bids and therefore there is a need to be able to identify the applicant by the deposit taking institution later to conclude the deposit agreement. For example, the deposit taking institution could identify MrBig vs MrThin being the applicant in contrast to ANONYMOUS for all parties being used in Breen. Breen failed to show this need to distinguish Deposit Applicant using a handle. Breen takes the view that it is a matching & contracting system and hence while

its users are ANONYMOUS to each other, they are known within the system which seeks to contract them without ever needing to reveal their real identities. Therefore, given Breen's system not only matches but also facilitates the full transaction cycle, it is obvious that there will not be any direct interaction between the parties and hence no requirement to distinguish them.

In either cases reading in combination, it is clear that they do not reveal our problem in soliciting competitive deposit rates/return nor the subject matter 'deposit auction'.

No suggestion to combine each other features or features are in conflict to each other.

There are no suggestions found in either prior arts to combine each other features. The examiner pointed to no evidence in particularly how one skilled in the art with no knowledge of our claimed invention would necessarily be motivated to combine the features found in a printing services auction system in view of a matching facility for regulated chemicals to reach our claimed invention. In particular, it could not be seriously suggested that a regulated chemical seller would allow a document service provider to bid for his chemicals. Similarly, would it be possible to consider a document printing requester to consider a bid from an anonymous chemical seller ? There is also no evidence that it is well known in the art to provide for anonymity for a brokered auction for document services.

Huberman shows no advantage of having this anonymity feature as it is already using a broker which could facilitate the transaction. Huberman taught the broker as the middle man shielding the identity of the requester and hence posed no advantage for said requester to be anonymous is clear. There is no known disadvantage in using a brokered system such that one skilled in the art would instantly recognize a need for anonymity by assigning a handle. In fact by using the teaching of Breen whereby the Document Service Provider is given the name 'Anonymous' and the requester with the name 'Anonymous', the broker system will be will fail for it could not distinguish them.

Secondly, it also begs the question, why would a brokered system need to use assignment of handles for the parties when the broker being the intermediary is well aware of the identities of both parties ? Huberman teach that a broker is to select and reveal the identity of the successful bidder (printer) to the printing requester made it clear the need for a broker, absent of any disadvantage.

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While Breen taught of anonymity of the kind whereby the real name of the person is concealed and substituted by the word "anonymous" , BUT this is not what the applicant is claiming, nor could it inherently show assigning a handle by reading a user agreement as suggested by the examiner. See Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1255-57, 9 USPQ2d 1962, 1965-66 (Fed. Cir. 1989) ("To read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality.")

And even if assigning handles is known, this does not mean it is also well known to do so for deposit applications as Breen teaches for matching of buyers/sellers of regulated chemical, a completely separate art. There is no evidence in Breen to show that a handle is necessary in order to solicit a competitive bid or to match an anonymous party. Also noted in Breen, the need for anonymity is an option (See Breen Fig 14A) whereas for our claimed invention is an necessity.

And even if one skilled in the art could find it necessary to incorporate our assigning of handle feature as an extension of its bare anonymity feature, said feature is in conflict with Huberman. In Breen, the need for anonymity lies with the business of matching regulated chemicals for sale is understandable. Parties involved in such business may find it advantage not to reveal their identities for commercial or security reasons and as such Breen's system accommodated by providing the full transaction cycle from matching to delivery. However, Huberman's brokering system requires these identities to be revealed by the broker at the conclusion of the bidding process in order to complete the transaction. Similarly, our claimed invention requires the deposit applicant (as opposed to broker) to reveal his identity in conflict with Breen.

There is nothing in Huberman to show that a requester would be agreeable to conclude a transaction with an anonymous printer provider which could only mean that both features are not combinable. Finally, we submit that there is no logical reason why an anonymity feature found in a regulated chemical exchange would lend itself to a document printer service provider since neither prior arts are analogous to each other and more pertinently no teaching to combine each other features to meet deposit auction system. As stated in Re Qua " There is no suggestion in either [prior art] patent as to how the features of the two devices could be combined as to meet the structure claimed. " (Ex parte Re Qua, 56 USPQ 279 (CCPA 1942)).

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Subject Matter : Deposit Auction System

The examiner had not provided evidence showing both prior arts are confronted with the same problem as we are resolving nor by combining both prior arts solve our problem of seeking competitive deposit returns. "a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests," In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979). In both prior arts there is no evidence of suggesting deposit auction system even by a wide reading including non-preferred embodiments (definition of 'fairly suggest' means including non-preferred embodiments). This clearly shows the examiner had used hindsight to link missing features which are not combinable to partially reached our claimed invention.

While auctioning and matching system (with or without a broker) are well known, they are not well known or obvious for deposit application whereby the need for handles are required at the outset in order to display the applications over a network. At the conclusion, these handles are removed to reveal the identities but only with the authorization of the handles' owners and not by brokers or other means. These differences identify the subject matter "deposit taking" field being different to the need for complete secrecy in Breen or in Huberman where it teaches a broker in control. Our submission above can be summaries in the following Table A

Features/Elements	Huberman	Breen	Our claimed Invention (claim 15)
Deposit Application	No	No	Yes and includes money or securities being on offer to attract a competitive return.
Assigning of handle	No	No (Option to be Anonymous only) See Fig 14A	Yes for deposit applicant during the auction period.
Type of System	Brokered Auction	Direct User Select	Non-Brokered Auction where user selects.
Anonymity	Identities known to broker.	Yes as an option and without handle	Yes by assigning a handle
Reveal Identity under control of deposit applicant/requester.	No. Broker reveal the identities of selected bidders for requester.	No if anonymity option is selected and per user agreement.	Yes

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Non-Monetary Bids for Deposit	No	No	Yes, bids are a combination of deposit terms or in exchange.
Displaying of Anonymous Application over a network	No, applications are send to selected bidders by broadcasting. (Col 5 line 1-4)	Yes	Yes
Deposit Taking Institution	No	No	Yes
Selection/Matching	Yes by Broker, a number of lowest price bids to be presented to requester or select by broker. (Col 4 line 5-10)	Yes by Buyers/Sellers	Yes by Deposit Applicant for the highest return for deposit

We submit that because Huberman in combination with Breen do not fairly teach this "deposit" system nor the subject matter of deposit auction nor the offer of money/securities and deposit rate bids or terms of exchange (elements not found in reading both prior arts), this obviousness action must fail. Viewed as a whole, neither prior arts in combination are directed at the same subject matter as found in our claimed invention of soliciting competitive deposit terms. The following details our claim by claim analysis traversing the examiner's assertions.

Claim 15,18,19

This is a 103(a) rejection. We respectfully traversed this rejection.

Evidential Analysis of Examiner's determination.

The applicant respectfully disagrees with the Examiner's assertions that Huberman in view of Breen discloses :

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A method for soliciting competitive terms of deposit operating on a deposit auction system, said system including a programmed computer connected to a network accessible by a plurality of users within a first selected period of time and anonymity means for concealing the identities of deposit applicants, the method executable at said computer comprising:

a) receiving deposit application from a prospective depositor who is a respective one of the users, wherein said application comprising permissible personal information and money, securities or financial equivalent deposit offer terms as subscribed by the prospective depositor;

b) assigning a handle to conceal the real identity of deposit applicant and displaying it anonymously;

c) receiving from at least one deposit-taking institution, who is a respective one of the users communicating over the network, at least a respective one of the responsive bids for said deposit application wherein said bid comprising at least one of responsive deposit terms, type of guarantees, payment schedule, deposit rate, securities in exchange and terms of exchange: and

d) receiving an electronic instruction from the deposit applicant, notifying and authorizing at least one selected deposit-taking institution to access a real identity and personal information of said applicant for a second selected period of time.

Applicant submits that Huberman had actually stated that his invention is for document service (Col 7 line 44) which bears no resemblance to the subject matter of deposit applications. How a document service could reveal deposit auction is not taught. There is no evidence shown by the examiner to reveal document service provider / applicant would inherently reveal any relationship to deposit taking institutions / depositors. Even the broadest interpretation of our claim construction could not reach document services. As mentioned in *Morris, 127 F.3d at 1053-54*, such broad interpretation must be reasonable. Thus, how one skilled in the ordinary art of deposit taking could read deposit auction in Huberman has not been shown by the examiner. Or stated differently there is no evidence to show one skilled in the art of deposit taking would consider Huberman cum Breen as sufficiently motivating to modify to show our claimed invention. And furthermore, there is no suggestion that Huberman will work without a broker as found in our claimed invention. We respectfully ask the examiner to show supporting evidence.

For each of the above subsection (steps) inclusive of elements will be rebutted as below:

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"A method for soliciting competitive terms of deposit operating on a deposit auction system, said system including a programmed computer connected to a network accessible by a plurality of users within a first selected period of time and anonymity means for concealing the identitics of deposit applicants, the method executable at said computer comprising :"

The examiner has not shown the element of anonymity or why would it be inherent for document service requester to be anonymous. The fact that Huberman details a broker process for such an auction service does not inherently shows its applicants/requesters are accorded anonymity by assigning handles nor is it known in the art that such an anonymity means must necessarily exists in an document service jobs request. The examiner presented col 3 and line 40-58. The examiner had asserted that because there is a teaching of 'brokered' auction this could be interpreted as concealing the identities.

Applicant respectfully disagrees with the Examiner's assertion that this could be interpreted as concealing the identities means by deposit applicant. The examiner does not cite any references or publications nor does the examiner provided any other evidence to support this contention. Even if by using a broker process wherein the identities are concealed, this by itself does not necessarily means the broker process is assigning the handles (the means of concealing) for deposit applicant. Huberman's method is merely designed to conceal the identities of the document requester and document service provider from each other and NOT from the broker during the auction process. This teaching could not fairly suggest that deposit applicant is in the same vein. In this claim it is clear the identity of the deposit applicant is concealed by assigning a handle and NOT by broker. And even if said identities could be concealed from the document broker without any disadvantages, it is not well known to do so via a computer network for deposit auction users (reading the preamble as whole) whereby NO broker is found in our claimed invention.

a) receiving deposit application from a prospective depositor who is a respective one of the users, wherein said application comprising permissible personal information and money, securities or financial equivalent deposit offer terms as subscribed by the prospective depositor;

Huberman details how to solicit documents service jobs through a broker and suppliers submitting bids to the broker. The examiner provided evidence from Huberman at Col 3 line 65 and col 4 lines 5-15 which actually read on how the document requester can avoid being locked to the winner or select the supplier of their choice.

The relevant evidences submitted by Examiner from Huberman are quoted in below for ease of examination: "For example, the customer can be given an opportunity to confirm the terms of the deal before agreeing to enter the transaction. Thus, after the broker closes the bidding and informs the customer of the winning supplier and price, the customer can (and typically will) be given an opportunity to indicate to the broker whether an acceptable result has been reached, and if not, to decline or cancel the job altogether. In this way, the customer is not bound to pay a price that is unacceptably high or to work with a supplier that the customer prefers to avoid."

Based on the evidence, we failed to see how this would show a deposit application comprising personal information, money, securities and terms of offer by depositor. It is well known that a document requester would only provide details on how many pages to print, where to send the printed documents etc. In Huberman, at Col 4 at line 45 showing the details required, say 100,000 copies of its annual report printed and mailed to its shareholders, particularly at line 60, number of copies, the size and paper quality, geographic distribution, time-table and any particulars that will be needed for supplier to estimate their cost for completing the job. There is no suggestion here that the requester is asking the printers to provide a quotation to print money and securities and less certain how the printer could provide a quote or bid on this to reach our bids elements of payment schedule or deposit rates or terms or exchange etc (see step c below). It is clear that the unresolved differences show Huberman's machine could not be adapted to solicit deposit rates.

If the examiner is suggesting a 'request' by itself in Huberman is capable to read into deposit taking then we must respectfully ask for evidence. As this patently does not anticipate, we respectfully ask the examiner to provide a reason to show why one skilled in the art would modify a document request to a deposit application request to support a prima facie obviousness.

c) receiving from at least one deposit-taking institution, who is a respective one of the users communicating over the network, at least a respective one of the responsive bids for said deposit application wherein said bid comprising at least one of responsive deposit terms, type of guarantees, payment schedule, deposit rate, securities in exchange and terms of exchange; and

The examiner provided Col 3 lines 45-65, Col 4 line 5-65 and Col 19 lines 45-60 and Col 20 lines 5-10). The evidence shows brokering process for document request solicitation but not for deposit application which could only attracts deposit taking institution. (Huberman Col 3 to Col 4 Line 1-19).

The evidence of claim 1 of Huberman actually do not show deposit taking institution, submitting a bid but rather "suppliers" and reading Huberman's specification must mean printing service providers. No evidence has been advanced to show how said suppliers is inherently known in the art as deposit taking institution. We submit that a deposit taking institution does not provide printing/document services nor vice-versa. It is also difficult to consider why a deposit taking institution could bid for a printing request in practice. Therefore prima facie this has failed to reveal deposit-taking institution limitation.

Our claim here is specific and requires the bids to be comprising "responsive deposit terms, type of guarantees, payment schedule, deposit rate, securities in exchange and terms of exchange" from a deposit taking institution while Huberman only shows " bids can be reconciled to establish a price ". We submit this 'price' does not anticipate our said elements and it is well known that a potential depositor is not interested in a price to print documents. He is interested to know what he can receive in exchange for depositing his shares or money with a deposit taking institution and hence the response must be such as terms of deposit, exchange terms etc.

There is no evidence to show it is commonly known in the document service industry to structure bid as "exchange terms of deposit" responding to their clients who are requesting for a price $ for their document service. The common practice for deposit taking institution is to provide a deposit rate (say 5 percent per annum) which could not be found from a printer service provider. This is to say if a requester asks for a price to print documents, would it be reasonable for the respondent service provider to return a bid in terms of an interest rate (5 %) or exchanging deposit for shares (200 IBM Shares) in effect paying the printing requester ? We submit that this will be most unusual in the printing business which again illustrate the difference subject matter being claimed here.

d) receiving an electronic instruction from the deposit applicant, notifying and authorizing at least one selected deposit-taking institution to access a real identity and personal information of said applicant for a second selected period of time.

The examiner provided evidence from Huberman Col 5 lines 10-30 and we reproduced below for ease of referencing in quotes: *"At the close of the auction, perhaps a few milliseconds or a few seconds later, the broker has determined which supplier has won the auction and at what price. Suppose that the supplier has its central offices in Kansas City, with various printing facilities*

and branch offices worldwide. The broker communicates the name and Internet address of the winning supplier to the customer, along with the quoted price, and provides the customer with an opportunity to accept or decline the transaction. Assuming that the customer accepts, the transaction goes forward. The substance of the job (e.g., the contents of the report and the names in the stockholder mailing list) can be provided electronically to the supplier by the customer, either directly or through the broker, along with accounting information such as the customer's billing address or credit card or electronic funds transfer information and the payment terms. The supplier tracks this information at its Kansas City headquarters and performs the printing and mailing at several locations, for example, printing 85,000 copies at sites in San Antonio and Omaha for mailing to U.S. addresses and 15,000 copies at a site in Singapore for mailing to addresses in Asia. The report is printed immediately and mailed later that day. Meanwhile, the broker collects a fee from the customer, or the supplier, or both, for services rendered. The fee can be paid electronically or conventionally. "

As evidenced above, the relevant steps are (1) the broker communicates the name and internet address and (2) at that stage the customer has the opportunity to accept or decline.

This is obviously in contrast to our claimed element (d) whereby the deposit applicant's selected deposit taking institution is notified and authorized to access deposit applicant's real identity. There is no broker in our claimed invention. In re Stencel, 828 F.2d 751, 754-55, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987) (function stated in claim distinguishes from prior art). Firstly our claimed element reveals the 'authorization' to be with our deposit applicant (receiving an electronic instruction from deposit applicant) and NOT with broker as in Huberman.

The words 'notified and authorized' means there is substantial control by deposit applicant which is not found in Huberman. This is clearly evidenced by Huberman where it is taught "At the close of the auction, perhaps a few milliseconds or a few seconds later, the broker has determined which supplier has won the auction and at what price ". (Col 5 line 8-11). This shows that the control as defined by 'determining ' is by the broker. The broker can also select a few printer providers to be shown to the requester leaving the decision to select (Col 4 lines 5-10) but this still do not show our deposit applicant authorizing his identity to be revealed to the deposit taking institution(s). This is the crucial difference where we reveal the identity of the deposit applicant (requester in Huberman) while Huberman teaches revealing the identities of the printers (deposit-taking institutions in our claim). The examiner did not explain this apparent difference and while

this may be a reversal of roles, it also reveals the fundamental control being in the possession of the applicant and not the broker.

The broker process is the root of Huberman's invention. In this claim, the bidders cum bids are displayed, allowing the anonymous applicant to select and not an intermediary (as there is no broker in our claim). Given a broker is used as in Huberman then what would be the motivation to modify using applicant to select and authorize access to his identity, in effect replacing the role of the broker ? To reach our claimed element, the examiner would have to provide reasons to extinguish the need for a broker in effect destroying Huberman's invention. No evidence has been drawn to our attention.

In our claimed element (d), the would be depositor directly selects the deposit taking institution allowing access to the depositor's real identity for a period of time without the aid of a broker. At all material times, the potential depositor has access to the real identities of the deposit taking institutions upon placing bids so it does not follow Huberman's teaching. Also note that given our deposit applicant has control to select, the final choice of acceptance or rejection therefore lies with the selected deposit taking institution and not with deposit applicant. This obviously is in contrast with Huberman which taught the document printing requester (deposit applicant) has the choice of accepting or rejecting. This difference in reversed roles qualifies as "dramatically structural difference" that are used for different purposes and in particular, what motivation could be found to modify so ?

Further, it is also clear that our deposit applicant has unfettered access to the bidders/bids during the auction and post auction which is not found in Huberman as it employs a broker. This again highlights the importance between using a broker where there is no direct interaction and our claimed invention where there is between the applicant and deposit taking institution. As noted because of this interaction, there is a necessary need for handle in order to distinguish each applicant to avoid confusion.

b) assigning a handle to conceal the real identity of deposit applicant and displaying it anonymously;

The examiner conceded that Huberman failed to teach assignment a handle but asserted this is found in Breen. The examiner provided evidence in Col 9 lines 58-65 and Col 14 lines 12-23 from Breen. This merely shows a user agreement incorporating anonymity for buyers/sellers.

We respectfully submit such an agreement is only evidence incorporating anonymity but by itself could not evidence Breen's system assigning a handle to conceal the real identity and displaying it anonymously. The examiner provided no evidence to show that "assigning a handle" must necessarily be obvious from user anonymity agreements nor any evidence to show why would one skilled in the art modify to assigning a handle. As stated in Rockwell Int'l Corp v US, 147 F .3d 1358, 47 USPQ 2d 1027, 1033 (Fed Cir 1988), " the consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success." The examiner made no assertion there is so defect in Breen's Anonymity means such that one skilled in the art would carry this process to assign handles.

From Breen's Col 15, lines 50-53 it shows that a seller can check a box to remain anonymous which means this is an option only and by itself does not infer that a transaction must necessarily be anonymous. In Breen, the teaching is merely to conceal the identity from other users without a handle is assigned by the system. For example see Fig 14A where the seller's name is "ANONYMOUS". There is a difference between a handle say " MrBig" and "ANONYMOUS". Therefore, it is clear our problem to ensure applicants could be identified later (after the conclusion of the auction period) by the deposit taking institution is not found in Breen. In fact, Breen has no such requirement given the system is both matching and contracting (Full transaction cycle).

Therefore, Breen's users who elect to be anonymous will have their names assigned as ANONYMOUS, (See All FIGS in Breen showing both seller and buyers with the name "ANONYMOUS") would not be an issue as compared to our need to distinguish them by a handle which is unique and identifiable BUT without revealing the real identity. This difference is crucial given that our deposit applicant albeit being anonymous (having been assigned a handle) could be distinguish amongst other applicants and interact with the deposit taking institutions in order to conclude the depositing agreement. In short, the deposit taking institution could distinguish between MrBig as one applicant and MrSmall as another and hence response appropriately. The same could not be said if all applicants appear to be ANONYMOUS as taught by Breen. This interacting means is also critical and distinguishes from Huberman as neither parties (buyer-seller) could interact DIRECTLY during the auction period.

The motivation.

Where obviousness is alleged to arise from a combination of elements across various references, proof of obviousness must include a suggestion, motivation, or teaching to those skilled in the art to make the combination. *Iron Grip Barbell Co. v. USA Sports, Inc., 392 F.3d 1317, 2004 U.S. App. LEXIS 25769 at *6, No. 04-1149, slip. op. at 5 (Fed. Cir. Dec. 14, 2004).*

The examiner provided the motivation as "in order to facilitate transactions between buyers and sellers without identifying the parties involve in the transaction".

We submit the above stated motivation fails to substantiate a need to combine with anonymity feature found in Breen. The operative words " in order " is used to positive this motivation as suggesting that transactions in Huberman will fail unless it has this anonymity feature. We respectfully disagree. The factual question is why should Huberman use the anonymity features for its clients when it is already clear that the broker has access to their identities. Is it logical to provide anonymity features to them when their identities are already known to the broker ? The answer may be YES if Huberman had taught of allowing the buyers and sellers to interact with each other directly or where Huberman could function without a broker. But there is no such suggestions in Huberman and rightly so given that if buyers and sellers could interact with each other directly then why the need for a broker ? And even if they are allowed to interact with each other directly, there is no suggestion that they need to be anonymous in order to facilitate a transaction. As we mentioned, the need for anonymity is depending on the trade or business which distinguishes the Art. In deposit taking, the need for anonymity is clear given no users will ever announce their identities online so that others such as the IRS could identify them with prejudice. The same cannot be said for Document Printing Requester.

The application of a broker is the root of Huberman's invention which is well known in the art to be able to facilitate transactions. The requirement of a broker in Huberman is therefore one justifiable for commercial self-interest in matching the parties and not that the parties (buyer-sellers) have to be anonymous so to facilitate transactions. The examiner provided no evidence on record that transactions in Huberman would fail without a broker for wanting of anonymity. Similarly even in Breen, the anonymity feature is merely an option (See Fig 14A) which fairly suggest that lack of this feature does not show the transaction in Breen will fail.

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Therefore, the motivation does not articulate why the specific need for anonymity or using handles as transactions between buyers and sellers could already be accomplished by Huberman's broker method. "unless the prior art suggested the desirability of [such a] modification" or replacement. In re Gordon, 733 F.2d 900, 902 , 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984).

There is no known defect in Huberman's brokering method (without client being anonymous to each other) such that one skilled in the art must necessarily see the anonymity in Breen as the specific answer and hence provide the motivation.

Furthermore, Breen requires anonymity to be a permanent feature to preserve privacy and real identities of its users by agreement if anonymity is selected by said users. There is no suggestion for deposit applicant to authorize revealing their identities on their own initiatives in view of our claim as a whole. In fact, Breen shows no teaching for its users to ever reveal their identities once they have opted to be anonymous.

Specifically, Breen also fails to reach our claimed element in two respects, the first being the handle is assigned to ONE party being the deposit applicant (Breen teaches both buyers and sellers electing to be anonymous and displaying "anonymous") and secondly Breen did not teach whereby one of the deposit applicant notifying and authorizing his identity to be revealed at the end of the auction. Huberman only teach the broker revealing the identity of the document service provider or alternatively being selected by requester. Any revelation by itself would be fatal in Breen as its user agreement expressly guarantee anonymity for both seller/buyer if selected. As such the user agreement is also in conflict with Huberman. In fact, the teachings are in conflict and taken as a whole, this simply undermined the motivation as asserted by the examiner "in order to facilitate transactions between buyers and sellers without identifying the parties involve in the transaction".

In the case where, Breen's users did not choose "anonymous" then their identities are known and hence would suggest it is not combinable with Huberman as this conflicts with the motivation stated by the examiner above.

Where both are anonymous then while it supports the examiner's asserted motivation, it is also in conflict with Huberman's teaching to reveal the winner's identity to facilitate transaction after the auction.

As to the displaying element, we submit the cited motivation fails to show this. There is no evidence in Huberman that its boardcasting method is unreliable such that one skilled in the art would modify it to displaying over a network. While Breen uses displaying method, no evidence has been shown how a boardcasting method could be combined with displaying method or the result of such a combination. In fact, given the nature of the business where a broker (having industry knowledge) is being used, its selective transmission may even be more effective than merely displaying over a network. We therefore respectfully submit the examiner had not been able to articulate a reason or a need for substituting this element and hence there is no teaching to combine found in Huberman to combine with Breen. *Kotzab, 217 F.3d at 1371* ("Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.").

Table B below shows how identities are accessed during and after the auction.

Table B	Breen (with Anonymity Option)	Huberman	Our claim 15
During Auction	Both buyer and seller are anonymous.	Requester is not part or even have access to the auction itself and has to rely on broker to provide the details. Broker knows both requester and suppliers but they are not known to each other. Furthermore neither requester nor suppliers could interact with each other until end of auction.	Our deposit applicant knows the bidders' identities and bids terms during the auction. Even though bidders do not know the applicants, they could distinguish them by their handles and hence could interact with them.
Post Auction	Both buyer and seller are anonymous as the transaction is facilitated by intermediary.	Broker submit a list of winners for requester to select, lists includes real identities of said suppliers.	Said applicants provide access to their real identities to selected deposit-taking institution for a determined period of time.

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In sum, we therefore submit that not all elements have been anticipated nor made obvious by Huberman in view to Breen, in particular, the elements of assigning handle, deposit auction system, bid comprising responsive deposit terms, type of guarantees, payment schedule, deposit rate, securities in exchange and terms of exchange, deposit application comprising permissible personal information, money, securities deposit terms of offer, notification and authorization by deposit applicant to access real identity of said.

The motivation to combine with Breen seems to be in conflict as Breen requires anonymity to be preserved by agreement while Huberman teaches revealing the identity at the end. There is no reason why Huberman would see any advantage to use anonymity as it relies on a broker without ever wanting the users to interact directly during the auction period. There is no evidence of any disadvantage where Huberman could not facilitate transactions such it must necessarily employ the anonymity method as the stated motivation suggest. Nothing had been shown as to why displaying over a network is preferable to broadcasting in Huberman.

Both prior arts also fail to reveal deposit applicant sending an electronic instruction to notify and authorizing access to said applicant's identity. Also critical is that, in claim 15 the deposit applicant has full knowledge of the bidders' real identities and their respective bids during the auction period contrary to the stated motivation where the examiner suggest anonymity for both parties. The fact that our claimed invention requires applicant's identity to be revealed at the conclusion of auction contradicts Breen's user anonymity agreement. And even if this is meet by Huberman albeit in reverse order and without applicant's control, it still could not be combined with Breen, which requires complete anonymity.

Viewing as a whole, the fact that Huberman taught of using a broker process which is not found in our claimed invention means functionally it is different from our claimed invention, nor is there any particular motivation to modify this to a non brokered auction so as able to incorporate anonymity features or such modification could reach our deposit auction system. See Kolmes v. World Fibers Corp., 107 F.3d 1534, 1541, 41 USPQ2d 1829, 1833 (Fed. Cir. 1997) (Invention was not obvious where there was no suggestion or motivation to modify teaching of reference.)

Applicant therefore respectfully submit that this claim be allowed.

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Claim 16

The method according to claim 15, further comprising a step of receiving from deposit applicant communicating over the network, an electronic instruction selecting at least one of responsive deposit-taking institutions bided for said depositor's application.

The examiner asserted that Huberman discloses a step of receiving from deposit applicant communicate over the network, an electronic instruction selecting at least one of responsive deposit taking institutions bided for said depositor's application.

Claim 16 is dependent on Claim 15 and hence covers all the elements expressed therein and as we have submitted is not made obvious by Huberman in view of Breen. On its own, this Claim merely shows deposit applicant selecting a deposit taking institution but Huberman only teaches selecting printing supplier which inherently could not reveal deposit-taking institution. The examiner provided evidence from Col 3 lines 45-65 and Col 4 lines 5-65 which shows broker process either selecting a winner or preparing a number of winners for selection by requester. There is no broker process in our claim and this claim invention is not selecting document service suppliers.

As for evidence Col 19 lines 45-60 and Col 20 lines 5-10, these are referencing Claim 1 of Huberman of the broker process selecting the customer and supplier and proposing the selection for a commercial transaction which we submit fail to teach our deposit applicant selecting the deposit taking institution (the element missing in Huberman).

Even where the requester in Huberman is given the opportunity to select the printer suppliers on its own accord (Col 4 line 5-10), there is still an issue where these printers suppliers are selected based on a criteria such as lowest prices as opposed to our terms of deposit or securities in exchange. This may be difficult for our claimed deposit applicant as his criteria is certainly to choose those who will return the HIGHEST for his deposit, in effect asking the document service provider to reward him for his deposits. In Huberman, the bidder is seeking to be compensated for his service.

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To anticipate a claim every element including deposit taking-institution and deposit applicant must be shown. Where elements are not found this could only be made obvious by a suggestion or by combining with a secondary reference. Further more as Claim 16 is also rejected based on 103(a), a motivation must be provided even where a single reference is used. None was evidence. (See B.F. Goodrich v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) (motivation to modify a single reference)

We respectfully submit this claim should be allowed

Claim 17

The method according to claim 15 includes a step of verifying the ownership of said money, securities or financial equivalent under deposit offer terms in the deposit application as subscribed by the prospective depositor.

The examiner asserted that Huberman discloses a step to verify the ownership of money, securities or financial equivalent and provided Col 1, lines 15-20 and Col 3, lines 40-55.

The evidence shows document services such as " printing, scanning, interpretation, binding, colorization, transmission, mailing, conversion and authentication, searching " etc. But note that authentication is further defined as within a document or in a database of documents at Col 1, line 21-22 which is not the same as verifying the ownership of money, securities etc.

This begs the question whether "authentication" as described in Huberman means specifically for money, securities or financial equivalent verification of ownership or legal entitlement. We respectfully submit that there is no evidence in Huberman relating to deposit taking and by the same, there could not be teaching to meet our claim element of verifying ownership for deposit.

Document service providers are further defined as professional print shops of publisher or in house corporate or government document services departments at Col 3 line 40-45. Documents are for example annual reports as per Huberman's example in Col 5 and even if we can extend this to the provision of printing money, securities and financial equivalent, this by itself does not mean document service provider could verify ownership of said.

Document service provider as in Huberman refers to the service of printing and in the process of printing of security document such as money, shares certificates etc, whereby the "document" must be checked or authenticated. Given these are newly printed documents, we submit such authentication could not mean verifying money or securities as presented by the deposit applicant. In contrast, the verification process is simply to ensure the physical money presented is not counterfeit or legal title is unfettered by checking the account details by electronic means over a banking network. We are doubtful document service providers could perform such verifications given that they cannot even take deposits by law and even if they can, this does not bestow they with access to the depositor's accounts over a banking network.

We respectfully submit that elements discussed above have not been anticipated by Huberman and hence this claim should be allowed. Further more as Claim 17 is rejected based on 103(a), a motivation must be provided even where a single reference is used. None was evidence. (See B.F. Goodrich v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) (motivation to modify a single reference)

Also note that in Claim 36, examiner acknowledged that Huberman fails to teach means for verifying the ownership of money. (At Action Letter page 6). We will deal with Claim 36 below as we are unable to resolve this apparent conflicting assertions and have to assume this may be an oversight on the examiner's part which is understandable given the work load.

Claim 18

The examiner has grouped Claim 18 under Claim 15. As this is a 103 (a) rejection, the examiner provided no evidence as to how this claim could be obvious. As this claim is dependent on Claim 15 hence it incorporates all our rebuttal as per Claim 15. Claim 18 is repeated below for clarity for rebuttal separately.

"The method according to Claim 15, further comprising a step of maintaining data representative of bids for the depositor's application in a database accessible to users over a network, said data comprising deposit terms, type of guarantees, payment schedule, deposit rate, securities in exchange and terms of exchange information on each of a plurality of submitted responsive bids.
"

The most pertinent point here is that the data is accessible to users including other potential depositors and deposit taking institutions (in Huberman to read other requesters and suppliers) .

As already mentioned, the fact that a broker is used, it will be unusual to see the bidders' data available over a network for users. In short, if the data is available it could only mean the buyers and sellers could interact directly without a broker which is contrary to Huberman's teaching of using a broker. The fact that the broker has to provide the winner's details including bided price to complete the transaction means Huberman did not suggest requester having access to the bidder's data or bid information during the auction process. (Col 3 line 65 to Col 4 line 5).

Huberman further describes that it can accommodate any type of auctions and gave examples in Col 10 line 35 to line 67. For example, it prefers sealed bid second price auctions, english and dutch auctions. The fact that it is a sealed bid would mean it is not accessible. While generally auctions are open in the sense that bids are clearly seen by others but given the broadcasting and broker approach as taught by Huberman, we are convinced that it is more probable than not that said broadcasting is targeted and private in contrast to our need for providing access to all users. It is also fair to submit that even if these data are accessible they are only limited to participating bidders and not to the requester (deposit applicant) given the commercial role of the broker in Huberman which is to facilitate the matching of a requester with a provider. In short, if a requester could go directly (having access) to the provider then there will not be a role for the broker.

And even if the bid data is accessible to all users, we submit Huberman still fails to show the various elements found in the bid. We respectfully submit that elements discussed above have not been anticipated by Huberman and hence this claim should be allowed. Further more as Claim 18 is rejected based on 103(a), a motivation must be provided even where a single reference is used. None was evidence. (See B.F. Goodrich v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) (motivation to modify a single reference)

Claim 19

The examiner has grouped Claim 19 under Claim 15 above but we beg to differ as the substance 'complete anonymity by assigning a handle for deposit taking institution' of Claim 19 is not found in Claim 15. The examiner also did not evidence where Huberman taught of our claimed element. If the examiner is asserting the missing element could be found in Breen, then we similarly

submit our earlier rebuttal for Claim 15 where Breen was applied. Claim 19 is repeated below for clarity.

" The method of according to claim 15, adapted to further promote a completely anonymous deposit auction comprising:

assigning a handle to conceal a real identity of the deposit taking institution. "

We respectfully transverse the examiner's rejection. Neither Huberman nor Breen taught deposit taking institution and document service suppliers or chemical buyers/sellers even by the widest definition could not be a deposit taking institution which for one usually is licensed to take deposit, a specialist business.

Secondly, this claim refers to anonymity for all participants during the deposit auction period (first period) which is not meet by Huberman as the identities of the participants are known to the broker.

Thirdly our requirement for handles to be assigned means the deposit applicants could interact directly with deposit taking institution albeit anonymously during the auction period since each are distinguishable by the handles. This could not be achieved by Huberman as the broker stands in the way. As for Breen which fails to show handles, there could not be any interaction given the users are indistinguishable by using "ANONYMOUS" as their identities. This is notwithstanding the examiner provided no motivation to show why would one skilled in the art modify bare anonymity to assigning a handle.

Lastly, Breen taught preserving anonymity for the whole transaction from matching to delivery without ever a need to reveal the identities as per its user agreement. Therefore, it would be contrary to have to reveal their identities after selection as per our requirement (completion of auction) in view of Claim 15. As previously discussed there is no teaching to combine Breen's feature with Huberman given their respective conflicts (ie need for total anonymity in Breen as opposed to Huberman's need to reveal the winner's identity for selection at completion of bidding).

We respectfully submit that elements discussed above have not been anticipated by Huberman and hence this claim should be allowed. Further more as Claim 19 is rejected based on 103(a), a

motivation must be provided even where a single reference is used. None was evidence. (See B.F. Goodrich v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) (motivation to modify a single reference)

Claims 24, 25, 26, 27, 28.

These rejections are respectfully traversed. As these claims are dependent claims to 15, 16, 17, 18, 19 respectively and different only by the statutory class, we submit our same rebuttal as before found above.

Claim 29, 30, 31, 32, 33

These rejections are respectfully traversed. As these claims are dependent claims to 15, 16, 17, 18, 19 respectively and different only by the statutory class, we submit our same rebuttal as before found above.

Claim 34.

This is a 103(a) rejection and we respectfully traversed this rejection.

The examiner has provided " as interpretive " and provided evidence in Col 3 line 40-58 in Huberman. We have produced the evidence as below:

"*The invention concerns the provision of document services by suppliers, such as professional print shops or publishers or in-house corporate or government document services departments, to customers, such as individuals, companies, or corporate or government departments. Document services can include, for example, printing, scanning, interpretation, text and image recognition, editing, reproduction, binding, colorization, transmission (e.g., by facsimile or by electronic mail), mailing, storage (e.g., in microphotographic or digital form), retrieval, format conversion, authentication, searching, and many others.*

In a specific embodiment that will now be described, the invention contemplates a brokered auction in which, for example, a customer who needs a particular document services job done can

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provide a request for these services to a broker. Suppliers can bid competitively on the request by submitting bids to the broker, who auctions the job off to (for example) the lowest bidder. "

Firstly, this claim is partially rejected under 103(a) by 'interpretive' means. Interpretive is often a question of intentions depending upon the prior art rather than strictly on facts found. This is when the facts do not reveal the elements (say deposit auction/deposit applicant when the facts only show document service auction) and where intentions must be drawn to justify the interpretation. We submit this 'interpretive' is not permissible as it is not the standard of obviousness rejection which seeks to factually find a reason for modification. Even if this is permissible, the examiner placed NO evidence on record to show that one skilled in the art would necessarily arrive at the same interpretation. If personal knowledge was used to gap this, then we must necessarily ask for official notice to be taken so to place this knowledge on record to enable us to rebut.

Obviousness requires some motivation to show our claimed invention in view of Huberman and could not be interpretive. Even if interpretive could be applicable here, the above evidence still fail to show our elements in particularly deposit auction system. We submit that "provision of document services by suppliers" could not be interpreted to mean deposit taking services by deposit taking institution. Furthermore document service is NOT deposit taking as read from Huberman. And there is no evidence from Huberman that it has the means to store a deposit application or to handle a request for deposit application. Also noting that our claimed invention has no brokering process under broker control as in Huberman. The language of the claims governs their scope and meaning. See *Dow Chem. Co. v. Sumitomo Chem. Co., 257 F.3d 1364, 1372 (Fed. Cir. 2001).* And it is clear that our claim element is unambiguously for deposit auction and not document services. The examiner also provided no motivation to show why one skilled in the art of document service must see it advantageous to adapt to receive a request for soliciting deposit taking rates without the use of a broker.

For element (a), the examiner asserts 'means for receiving a deposit application' is read as a request in Huberman. This reasoning still fail since Huberman did not show the means of receiving deposit application nor is there any evidence to show a request means in Huberman is capable of receiving a deposit application. For example see Huberman at Col 4, line 57-65 which described *"The purchasing officer (more precisely, a software process that represents the purchasing officer or her company) places the printing and mailing request with the broker, providing particulars such as the number of copies to be printed, the size and paper quality of the*

report, the geographic distribution of the stockholders on the mailing list, the timetable for completion of the job, and any other particulars that will be needed for suppliers to estimate their costs for completing the job". There is nothing in this to show the purchasing officer wants to deposit money, securities etc as per our claimed.

As to the substance and form of the deposit application, the examiner provided Col 3 line 65 and Col 4 line 5-15 which read providing the customer (requester in Huberman) the right to confirm the term of deal before agreeing and about upper prices and broker offering a number of winners for requester to pick etc. We submit this is not relevant to our need to provide a deposit application providing personal information, money, securities or financial equivalent deposit offer terms. In short, deposit offering terms could not be the same as document service requests with or without a upper price for the bids or able to select winners from brokers. It is quite evident as seen from one skilled in the art by providing a document service request will not result in a responsive deposit bid by any deposit taking institution. Similarly, a broker or printer supplier in Huberman would not know what to do with a deposit application indicating deposit terms of offer simply because they are not in the same business and hence logically their requests or applications could not be anticipated or obvious or be interpretive to be similar.

As for subsection (c) the examiner provided evidence at Col 3 line 65 and Col 4 line 5-15 to show depositing term bids. The evidence provided shows how the document service requester could select the winner from a number of winners provided by the broker and a way for said requester to confirm a deal. We submit while this shows bids were provided but there is no evidence to show teaching of our bid in deposit terms providing terms for depositing funds. It is not reasonable to conclude that a bid from a printer supplier could anticipate or obvious to one submitted by a deposit taking institution based on its function and form.

The examiner further provide evidence from Huberman Col 3 lines 45-65, Col 4 lines 5-65, Col 19 lines 45-60 and Col 20 lines 5-10.

We have reproduced this evidence for clarity.

Col 3 lines 45-65 reads "*Document services can include, for example, printing, scanning, interpretation, text and image recognition, editing, reproduction, binding, colorization, transmission (e.g., by facsimile or by electronic mail), mailing, storage (e.g., in microphotographic or digital form), retrieval, format conversion, authentication, searching, and*

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many others.

In a specific embodiment that will now be described, the invention contemplates a brokered auction in which, for example, a customer who needs a particular document services job done can provide a request for these services to a broker. Suppliers can bid competitively on the request by submitting bids to the broker, who auctions the job off to (for example) the lowest bidder.

The auction can, but need not, result in a transaction between a particular supplier and the customer for the job at an agreed-upon price. Preferably, the customer is afforded one or more fail-safe mechanisms by which to avoid entering into an unfavorable transaction if the auction results prove unsatisfactory. For example, the customer can be given an opportunity to confirm the terms of the deal before agreeing to enter the transaction. "

Col 4 lines 5-65 reads "*In this way, the customer is not bound to pay a price that is unacceptably high or to work with a supplier that the customer prefers to avoid. Alternatively, instead of simply picking a winner, the broker can offer the customer a choice of several possible winners, based on (for example) the three or four lowest bids. The customer can then be given an opportunity to select from among these candidates, or to decline or cancel. Still further, the customer alternatively or additionally can specify a reservation or maximum price to the broker in advance, either before the start of the auction or during the auction, and the broker will screen out bids above this price. The broker will not propose to the customer a transaction in which the job is to be performed for a price above the reservation price.*

In the specific embodiment, the auction is conducted through the medium of a computer network, such as a wide-area network. The customers, the suppliers, and the broker or brokers are represented by software processes that can communicate with one another across the network. Customers, suppliers, and brokers can be geographically distant from one another, and can themselves be geographically distributed entities. Nevertheless, interprocess communication is typically very rapid, even virtually instantaneous. Moreover, the computerized auction sequence can be largely or entirely automated, so that it can be conducted with minimal human intervention.

The invention can facilitate the growth of an open market for document services, a market whose business practices are very different from the secretive pricing practices of today. In this new market, customer requests can be placed rapidly and continuously, and many customer requests

can be placed simultaneously. Suppliers can respond very quickly to the customer requests with competitive bids, and brokers can rapidly conduct computerized auctions to match customers with suppliers. It is possible for a final transaction to be ready for customer confirmation and subsequent execution within seconds, or even milliseconds, of a customer's initial request, even if the customer is in Chicago, the winning supplier in Los Angeles, and the broker a distributed entity somewhere in cyberspace.

A concrete example illustrates these ideas. Suppose a company in Des Moines, Iowa needs 100,000 copies of its annual report printed and mailed to its stockholders. According to the invention, the company's purchasing officer logs onto, for example, the Internet (assumed here to support data encryption and other protocols to ensure the security of financial transactions) and contacts a document services broker. The broker's physical geographic location is of no consequence to the company's purchasing officer; all the purchasing office needs to know is that the broker has a World Wide Web site or other suitable site on the Internet, and can accept the purchasing officer's request electronically at that site. The purchasing officer (more precisely, a software process that represents the purchasing officer or her company) places the printing and mailing request with the broker, providing particulars such as the number of copies to be printed, the size and paper quality of the report, the geographic distribution of the stockholders on the mailing list, the timetable for completion of the job, and any other particulars that will be needed for suppliers to estimate their costs for completing the job. "

Col 19 lines 45-60 and Col 20 5-10 reads

" In a system comprising at least one processor, a method comprising the steps of:

executing in the system a plurality of processes including

a first collection of participant processes, the processes of the first collection being customer processes, each customer process representing a customer,

a second collection of participant processes, the processes of the second collection being supplier processes, each supplier process representing a supplier, and

a broker process capable of serving as an intermediary among the customer and supplier processes;

providing a description of a commercial document service to the broker process;

responsively to the description thus provided, conducting an auction for the document service, the auction including the steps of

submitting a set of bids for the document service, each bid of the set being submitted from a participant process,

receiving the bids of the set in the broker process,

determining in the broker process responsively to the received bids whether the bids can be reconciled to establish a price, and

if the bids can be reconciled performing the steps of;

establishing a price for the document service with the broker process;

selecting with the broker process from among the customer processes a first preferred process, the first preferred process representing a preferred customer;

selecting with the broker process from among the supplier processes a second preferred process, the second preferred process representing a preferred supplier;

proposing with the broker process a commercial transaction wherein the document service is to be provided for the preferred customer by the preferred supplier at the established price. "

The above evidence mainly shows that "a set of bids for the document service are submitted" but this by itself does not reveal type of bids for deposit terms as found in our claimed invention. Furthermore, reading this bids to mean something capable of showing deposit terms bid when no teaching is found in Huberman is hindsight analysis. See W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed.Cir.1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.").

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As for part (d) the examiner provided Col 5 lines 10-30 which reflects what was said about the broker providing the winner supplier to the requester.

However, our element actually refers to deposit applicant notifying and authorizing deposit taking institution and not broker providing details of printer supplier to requester. In essence, how deposit applicant's identity is revealed is under the control of the applicant. This is not taught by Huberman which uses a broker as a means to provide the details of supplier to requester.

In our claimed invention, this means the deposit applicant must have first access to select without being supplied by broker as in Huberman. But more pertinent is the evidence in Huberman actually showing the requester receiving information about supplier while in our claim element is the depositor providing its identity to the selected deposit institution. This reverse role without a broker must mean at least the identity of the deposit taking institution is already known by deposit applicant whereas none is known by either parties before the broker actually provides this information in Huberman. The examiner provided no reason to show this difference and which could only mean this difference is not appreciated. In a 103(a) rejection, a motivation must be found in Huberman order to bridge this difference which the examiner had not shown. In re Chu, 66 F.3d 292, 298, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995) (stating that even when changes from the prior art are "minor" or "simple," an inquiry must be made as to whether "'the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes'" (quoting Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 935, 15 USPQ2d 1321, 1324 (Fed. Cir. 1990))).

A patent claim is obvious, and thus invalid, when the differences between the claimed invention and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103; see also Graham v. John Deere Co., 383 U.S. 1, 14, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966); In re Dembiczak, 175 F.3d 994, 998 (Fed. Cir. 1999).

It is obvious there is nothing to show our subject matter as a whole in soliciting deposit rates is obvious from reading Huberman. See *Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987)* (indicating that a key preliminary legal inquiry in obviousness analysis is: "what is the prior art?"). Huberman's invention is not in the art of deposit taking, shows no evidence of

solving our problem and by itself there is no evidence to show one skilled in the art would be motivated to modify.

Motivation to combine with Breen.

As for element (b), the examiner conceded that Huberman failed to teach anonymity means for assigning a handle and asserted this is provided Breen and motivated by " in order to facilitate transactions between buyers and sellers without identifying the parties involved. ".

We submit that this motivation is unsound as it must necessary assert that a brokering process in Huberman could not facilitate a brokering process without identifying the parties involved. As noted above in Claim 15 for element (b) of our rebuttal herein incorporated, using a broker is the root of Huberman's invention and must necessarily means there is no advantage in applying anonymity by handle means. In short, the presence of a broker must mean a transaction could be facilitated without anonymity means.

Alternatively, this motivation also fails to address why there is a need for anonymity (without identifying the parties involved) in order to combine with Breen. No evidence had been shown that a transaction could not be done without anonymity and in fact Breen's anonymity is merely an option (Fig 14A) which suggest that even in the circumstances of regulated chemical sale, anonymity is but an option rather than the necessarily element to facilitate transactions.

We respectfully traversed this rejection for the reasons above and ask the examiner to allow this claim.

Claim 35,37,38

Claim 35, 37 and 38 actually correspond to claim 16, 18,19 and therefore we submit the same rebuttal as above found in claim 16,18,19.

We respectfully submit prima facie have not be made out and we must ask these claims to be allowed.

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Claim 36

Applicant respectfully disagrees with the Examiner's assertion that this feature is old and well known in the art. The examiner does not cite any references or publication nor does the examiner provide any other evidence to support this contention. The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. *In re Ahlert, 57 C.C.P.A. 1023, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970)* ... When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See *37 CFR 1.104(d)(2)*. Such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on "subjective belief and unknown authority." *Lee, 277 F.3d at 1344.*

If the examiner has used personal knowledge here to bridge the gap in showing obviousness, then it will be necessary for us to ask for evidence. "In re Lee, 277 F.3d at 1345, 61 USPQ2d at 1435, the court said that such "knowledge must be articulated and placed on the record." Id. The court further explained that 'deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.' Id. at 1344, 61 USPQ2d. "

The examiner asserted at page 6 of Action Letter *" However verifying the ownership and authenticity of a document is old and well known in the art because the document would have had to consist of an identification number, name of the owner and date acquired. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Huberman to include verifying the ownership and authenticity of a document because the document would have had to consist of an identification number name of the owner and date acquired. "*

Firstly, the examiner did not provide any example or type of document must necessarily consist of identification number, name of the owner and date acquired. If the document is a book, then while it has ISBN, it will be rare to see the name of the owner (as opposed to the name of the author or publisher) on the book unless the owner actually provides for this. In short a document

is not necessarily an object where ownership is that critical as found in say a share certificate or dollar bill.

Consider a document such as a book was published by XYZ and authored by ZZZ. However, this document and other copies of the same document could be owned by Mr Smith, Mrs Waltons or Ms Wong and while it may be easy to identify the respective ownership provided Mr Smith actually wrote his name on the document, the same cannot be said of money since Mr Smith could not write his name or date acquired on each dollar bill he happens to own. As for securities such as shares which may be in electronic form or physical form, the task is more difficult. For instance, if the shares are in electronic form, the verifier would need to inspect the share registry (physically or electronically) and if it is in the physical form, the shares may be in the name of another with a blank transfer form attached or in the instance of bearer bonds, there is no name on these "documents". In modern society financial assets are mostly stored electronically in accounts which evidenced ownership being linked to the name to the account and therefore there is a need beyond merely inspecting whether a name is found on the document, date acquired or identification number. However, the question is why would a document service provider be motivated to verify ownership of "documents" belonging to a deposit applicant given that they obviously could not take deposit nor operate as a deposit taking institution ?

Verification of ownership is a common requirement for deposit taking institution for huge deposit where they have to make reference to Banking regulators. Even if this is an old art, we are very doubtful this is common or known in the document service industry to verify money or shares especially when they are not offering a deposit taking service. The examiner provided no evidence here. There is nothing to suggest that merely because the document consist of an identification number, name of the owner and date acquired, this by itself would motivate the document service provider to verify its ownership.

And even if verification of ownership is well known in the art, it is not well known to do so for deposit auction as in our claimed invention reading with claim 34 (which this claim is dependent) over a network. Lastly, there is nothing in Huberman to reveal this problem. As stated in In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997), the nature of the problem cannot be used as motivation when the problem had not been previously identified anywhere in the prior art.

Therefore we must respectfully ask this claim to be allowed.